

REMARKS

Introduction

Applicant wishes to thank the Examiner for the time and courtesies extended to applicant's representatives in the Examiner Interview conducted on December 3, 2002 (the "Interview").

Applicant has canceled claims 10-12, 18 and 21-23, as being drawn to a non-elected invention. Applicant expressly reserves the right to file a divisional application directed to the invention of the canceled claims.

Applicant has amended the application in accordance with the suggestions made by the Examiner during the Interview, and to correct other minor errors that applicant has recently discovered.

In addition, applicant provides below a more comprehensive discussion of the reasons that applicant's invention is not obvious in view of any combination of cited prior art than was possible during the Interview.

Summary of Examiner Interview

The Examiner graciously granted applicant's representatives (Robert Morris, George Kanabe, and Andrew Van Court) an interview on December 3, 2002. During the Interview, various differences between the applicant's invention and the cited prior art were discussed.

Applicant argued that the prior art cited by the Examiner does not show or suggest the features of applicant's claimed invention. In particular, the obviousness rejections under 35 U.S.C. § 103(a) were discussed with regards to Greiner U.S. Patent No. 6,253,918 (hereinafter, "Greiner"), Barhite U.S. Patent No. 746,264 (hereinafter, "Barhite") and Wooster U.S. Patent No. 242,805 (hereinafter, "Wooster"), all of which are already of record.

The Examiner maintained the rejections of applicant's claimed invention over a combination of the cited references, but invited applicant to provide a more thorough explanation as to why applicant believed that the obviousness rejection should be withdrawn.

In addition, applicant agreed to remove the word "hollow" from the claims.

Amendments of the Specification and Claims

In applicant's March 25, 2002 Supplemental Reply to Office Action, which provided clean copies of the paragraphs amended in the March 13, 2002 Reply to Office Action, the final sentence of the paragraph starting at page 8, line 19 was inadvertently omitted. This sentence was subsequently included in both the clean version and the marked up version of the paragraph in applicant's November 15, 2002 Reply to Final Office Action. Nevertheless, in order to remove any possibility of confusion, applicant has amended the paragraph starting at page 8, line 19 to include the final sentence of the paragraph as found in the originally filed specification.

In accordance with the Examiner's suggestions during the Interview, applicant has amended claims 1, 3, 5, 13, 17, and 26 in order to remove the word "hollow."

Claim 1 has also been amended to correct typographical errors. Applicant has amended lines 7-8 of claim 1 to remove the phrase "[of said label container area]," which was inadvertently left in the clean copy of the claim in applicant's November 15, 2002 Reply to Final Office Action. In addition, lines 11-12 of claim 1 has been amended to properly include the phrase "at least one label support member that is

located." This amendment has been introduced to avoid the possibility of confusion which may have resulted from the typographical error in the marked up version of the claims appended to the November 15, 2002 Reply, which incorrectly included the phrase "a label support member situated" instead of "at least one label support member that is located."

Applicant has amended claim 4 to include the phrase "said label support member" and claim 13 to include the phrases "a label support member" and "said label support member."

Applicant has amended the title to "Apparatus For Storing Food" to reflect the previous cancellation of method claim 25.

No new matter has been added by any of these amendments.

Proposed Drawing Change

Applicant submits herewith a proposed amendment to FIG. 3, with the changes shown in red, to correct typographical errors in the reference numerals "24" and "32," which were inadvertently switched. Support for the proposed amendment can be found on page 8, lines 22-23, of applicant's originally filed specification.

Applicant's Remarks Regarding the
Rejections Under 35 U.S.C. § 103(a)

Claims 1-9, 13-17, 19-20 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Barhite, Wooster, Dorney U.S. Patent No. 6,062,380 (hereinafter, "Dorney"), Hepburn U.S. Patent No. 4,927,041 (hereinafter, "Hepburn") and Nelson U.S. Patent No. 5,024,210 (hereinafter, "Nelson").

Applicant respectfully submits that none of the prior art cited by the Examiner, including Barhite, Wooster, Dorney, Hepburn, Nelson and Greiner, alone or in combination, make applicant's claimed invention obvious in any manner.

Applicant's invention is directed toward a food storage container having a fixably sealed lid and a channel region that is formed between an inner and an outer wall. Moreover, the channel region of applicant's claimed food storage container has a label container area, with a label support member, that is readily accessible by users for the insertion of identifying labels. This configuration facilitates the placement of an identifying label, which may be used to provide information regarding the contents of the food storage container, into the label container area.

Additionally, the label container area allows a user to read the identifying label of the food storage container without having to open the container or remove the container from a cooling unit (e.g., a freezer), while still protecting the label from the effects of the environment in which the container is placed (such as frost or condensation).

As argued during the Interview, applicant respectfully submits that none of the cited references, alone or in combination, shows or suggests applicant's claimed invention. In particular, applicant respectfully submits that the requisite "motivation to combine" the cited references in order to obtain the features of the present invention is not present, and does not exist except from applicant's own specification. However, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d, 1780, 1784 (Fed. Cir. 1992); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the

prior art to defeat patentability -- the essence of hindsight"); In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)("[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

Applicant respectfully submits, as set forth more fully below, that the cited prior art references are isolated disclosures and that there is no motivation to combine them, absent applicant's specification. Thus, in accordance with the well-established law of the Court of Appeals for the Federal Circuit, the obviousness rejection of the claims under 35 U.S.C. § 103(a) should be withdrawn. In particular, none of the cited references teach the inclusion of a label container area in which a label can be placed such that it can be viewed by the user.

The Examiner has relied on one of Barhite, Wooster and Greiner (relied on in interviewing with applicant) as the primary reference for the obviousness rejections in combination with at least one other reference. Each of those combinations, however, fails to satisfy the requirements set forth by the Federal Circuit (Dorney, another reference cited by the

Examiner, fails as a primary reference on its face because Dorney's two-walled construction is sealed to prevent a potentially dangerous substance from being removed from the chamber between the walls - clearly this teaches away from opening Dorney's chamber to permit a user to place labels therein).

Applicant now addresses each of the other references individually. It is important to note that the test for obviousness requires the viewpoint of a person skilled in the art at the time the invention was made. Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 956, 43 USPQ2d 1294, 1296 (Fed. Cir. 1997) ("Good ideas may well appear 'obvious' after they have been disclosed, despite having been previously unrecognized."); Manual of Patent Examining Procedure, 8th ed. (MPEP), page 2100-121 (when making a proper determination of obviousness, "the [E]xaminer must step backward in time [to] when the invention was unknown and just before it was made ... applicant's disclosure must be put aside in reaching this determination ... [and] impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." Thus, the relevant question is whether that person, with the cited references sitting in

front of him, would have come up with the claimed invention. Applicant respectfully submits that the answer is "NO".

Barhite provides an improved cream separator comprising an inner shell or milk-receptacle 10, a surrounding shell or water-receptacle 14, and annular and secondary covers 20 and 23. In order to produce cream from the milk contained in milk-receptacle 10, cold water is introduced into water-receptacle 14. The Examiner equates Barhite's water-receptacle 14 with applicant's claimed label container area between the inner and outer walls.

In rejecting applicant's claimed invention over Barhite in view of Dorney or Greiner, the Examiner asserts that it would have been obvious in light of the translucent wall in Dorney (or Greiner) to "modify the material of the outer wall of Barhite to be translucent in order to see an item placed within the space between the inner and out walls" (Examiner's Action, page 3). The relevant question is, absent applicant's claimed invention, "Why?"

First, there clearly is no suggestion or teaching in Barhite for the outer wall of the water-receptacle to be replaced with a translucent material (e.g., as found in Dorney or Greiner).

Second, the Examiner's proposed modification -- replacing the outer wall of water-receptacle 14 with a translucent material so that labels placed therein could be viewed -- teaches away from the essence of what Barhite's patent is for. In particular, Barhite's chamber is intended to be filled with water or some other cooling agent, not a label. It is never intended to be a dry receptacle. To convert it to a dry receptacle for labels would eviscerate Barhite's invention. Thus, if Barhite's water-receptacle 14 was empty of water or other type of cooling agent, there would be no invention to speak of. Moreover, Barhite explains the desirability of having minimal exposure "of the surface of the inner receptacle ... so that there will be a minimum of loss from radiation" (Barhite, column 1, line 49 to column 2, line 1). Clearly, replacing the water-container 14 with a translucent material renders the milk-receptacle 10 vulnerable to radiation (e.g., sunlight or a light bulb).

In view of: (1) Barhite's complete lack of suggestion to replace the metal outer wall with a translucent material; (2) the fact that the replacement of Barhite's cooling agent chamber with a dry label container area eviscerates Barhite's invention in its entirety; and (3) the fact that Barhite

teaches against the use of a translucent outer wall because it would subject the inner chamber to unnecessary radiation, applicant respectfully submits that the only support for the Examiner's suggested obviousness combinations based on Barhite is applicant's claimed invention, which is the essence of hindsight reconstruction. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1994) ("the test for obviousness requires that the references, not the Examiner, provide teaching or suggestion supporting the combination of references offered"); MPEP, page 2100-124 ("[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination").

Moreover, applicant respectfully submits that the Examiner's proposed modification of Barhite is evidence that there is no suggestion or motivation to combine because the proposed modification renders Barhite unsatisfactory for its intended use (without water to cool the milk found in milk-receptacle 10, the cream separator of Barhite would be rendered useless). MPEP, page 2100-124 ("[i]f proposed modification

would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification").

Applicant now addresses the use of Wooster as a primary reference in the Examiner's obviousness combination. The Examiner has asserted that it would have been obvious "to modify the material of the outer wall of Wooster to be translucent in order to see an item placed within the space between the inner and outer walls" (Examiner's action, pages 3-4). Applicant respectfully submits that Wooster, like Barite, cannot be used as a primary reference for the obviousness combinations suggested by the Examiner.

Wooster provides an improved milk cooler, comprising a cabinet or outer wall A with a hinged lid B, and a swinging or sliding door C. A partition D, having a central perforation E into which an elongated milk-receptacle F is placed in a water tight manner, is secured within the cabinet A. The upper portion of milk-receptacle F extends above partition D, and the lower portion extends below the same. The upper region of the cabinet separated by partition D is lined with sheet metal to form ice-receptacle G. Ice and/or cold water is introduced into the ice-receptacle G to cool the

contents of milk-receptacle F, for the purpose of producing cream. The Examiner has equated Wooster's ice-receptacle with applicant's claimed label container area.

Wooster, like Barhite, fails to show or suggest replacing the outer wall (which is "preferably made of wood" (Wooster, column 1, lines 21-22)) with a translucent material. In addition, the proposed modification of Wooster -- the replacement of the ice-receptacle with a dry label container area -- would eviscerate the essence of Wooster's invention. Finally, the proposed modification of the outer wall with a translucent material would also result in the central chamber being subjected to undesirable radiation that could significantly reduce the effectiveness of Wooster's apparatus, even if it were still used as intended.

Applicant respectfully submits that Wooster, like Barhite, fails to provide the requisite suggestion to modify and, if fact, teaches away from such a modification. Absent such a suggestion, it is improper to classify this type of modification as obvious. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the law requires some 'teaching, suggestion or reason' to combine cited references); In re Kotzab, 217 F.3d 1365, 1370,

55 USPQ2d 1313, 1316 (Fed. Cir. 2000) ("identification in the prior art of each individual part claimed is insufficient ... there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant"); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1478, 45 USPQ2d 1498, 1502 (Fed. Cir. 1998) ("the mere possibility that the [prior art] references could have been combined is insufficient to demonstrate that the claimed invention would have been obvious").

Neither Barhite nor Wooster shows or suggests applicant's claimed label container area (which must be dry for it to function as claimed, so that labels placed therein by a user are not immediately destroyed). Rather, placing a label within the region suggested by the examiner (e.g., between Wooster's cabinet A and milk-receptacle F), would result in the destruction of any such label, given that this receptacle is a receptacle for containing ice or cold water. Moreover, given that there would be no utility of Barhite's or Wooster's milk coolers without such ice or water being in the region in question, the modifications suggested by the Examiner cannot be maintained in light of the MPEP and the well-established law of the Court of Appeals for the Federal Circuit, as they would

"render the prior art invention being modified unsatisfactory for its intended purpose" (see above).

It should also be noted that any obviousness analysis must be based, among other things, on "secondary considerations, if any, of nonobviousness." McGinley, 262 F.3d at 1349. Applicant respectfully submits that given the fact that both Barhite and Wooster were patented about 100 years ago, and that translucent food containers have existed for decades, the failure of those skilled in the art to form applicant's claimed invention provides significant secondary indicia of nonobviousness.

Finally, applicant addresses Greiner. Greiner shows a "decorative container" having a channel region to permit the displaying of items for the purpose of decoration within the internal cavities of the decorative container (see, e.g., Greiner, column 1, lines 33-52). The Examiner has equated this region with applicant's label container area, and has suggested that Greiner be modified by Wooster or Barhite to include applicant's claimed label support member so that a label placed in that region would not simply fall to the bottom of that region.

Applicant respectfully submits that the Examiner's proposed modification of Greiner in view of Barhite or Wooster cannot be supported. Applicant respectfully submits that there is no motivation or suggestion in Greiner to include a label support member, such as one of the "stays 28" of Barhite, for the purpose of supporting an identifying label, as found in applicant's claimed invention. Rather, including such a label support member would essentially destroy the ability of Greiner's claimed invention to function because it would undesirably block the internal cavities of Greiner's decorative container, thereby prohibiting or limiting their use for the intended decorative purpose.

Accordingly, applicant respectfully submits that the combinations of Greiner with Wooster or Barhite suggested by the Examiner are not supported by the teachings of the prior art, but rather, are based on hindsight reconstruction in view of applicant's disclosure. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious").

For at least the above reasons, none of the cited references (including Barhite, Wooster, Greiner and Dorney), alone or in combination, show or suggest the features of applicant's claimed invention. In particular, none of the cited references (including Nelson and Hepburn) show or suggest applicant's claimed label support area and label support member.

For at least the reasons above, applicant respectfully submits that independent claim 1, as amended, and new independent claim 26, are allowable over any combination of the cited prior art. Moreover, each of the other pending claims are dependent claims which are also, therefore, allowable over the prior art. Accordingly, applicant respectfully requests that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

For at least the above reasons, applicant respectfully submits that this application, including each of claims 1-9, 13-17, 19-20, 24 and 26, is in condition for

allowance. A favorable action is respectfully requested in light of the foregoing amendments and remarks.

Respectfully submitted,

A handwritten signature in cursive script, reading "George L. Kanabe". A long, sweeping horizontal line extends from the end of the signature to the right.

George L. Kanabe

Reg. No. 51,858

Agent for Applicant

FISH & NEAVE

Customer Number 1473

1251 Avenue of the Americas

New York, New York 10020-1104

Tel.: (212) 596-9000

APPENDIX A

AMENDED SPECIFICATION
MARKED TO SHOW AMENDMENTS

The title of the invention:

-- [METHODS AND] APPARATUS FOR STORING FOOD --

Page 8, line 19 to page 8, line 35:

-- FIG. 3 shows an illustrative cross-section of a hollow channel 30 that provides increased thermal protection from the effects of cold storage. In this embodiment, inner walls 22, outer walls 24 and channel barrier 32 may be fabricated in such a way that an insulating material 60 is placed within the closed cavity therein. Insulating material 60 may thus be located within the volume of space below channel barrier 32, as well as on the bottom of the food container. Insulating material 60 may include any insulating material known to persons skilled in the art, such as STYROFOAM, the polystyrene foam insulation material, ceramics, fiberglass, or anything else suitable for providing insulation. Insulation materials 60 may help prevent freezer burn of the food contained within container 20. Insulation material 60 may

also provide additional structural support to container 20
by adding rigidity to the walls of container 20. --

APPENDIX B

AMENDED CLAIMS
MARKED TO SHOW AMENDMENTS

1. (amended) A food storage unit, comprising:
a container comprising a container top, a container bottom, an inner wall and an outer wall, said inner and outer walls forming a [hollow] channel there between, said [hollow] channel including a label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall [[of said label container area]] being translucent such that a label placed in said label container area may be read without being removed from said food storage unit;

at least one [a] label support member [situated] that is located within said [hollow] channel, said label support member that prevents a label inserted into said label container area from falling to the bottom of said [hollow] channel; and

a lid that may be fixably attached to said container top to seal said container CLOSED.

3. (amended) The food storage unit of claim 1, wherein only one side of said [hollow] channel is accessible by said user for said insertion of said label.

4. (amended) The food storage unit of claim 1, wherein said label support member is positioned on one side of said container parallel to said lid between said inner wall and said outer wall, said label support member that provides a surface that a label would rest upon after being inserted into said label container area.

5. (amended) The food storage unit of claim 1, wherein said [hollow] channel includes a portion that is inaccessible by said user, said container further comprising:
an insulating material located within said inaccessible portion of said [hollow] channel.

13. (amended) The food storage unit of claim 9, wherein said [container further comprises:

a barrier] label support member is positioned parallel to said lid between said inner wall and said outer wall, said label support member which renders a portion of

space between said inner and outer wall inaccessible to said user, [;] said container further comprising:

an insulating material located within said inaccessible portion of space.

17. (amended) The food storage unit of claim 16, wherein said ridge and said [hollow] channel form a substantially airtight seal when mated together.

26. (amended) A food storage unit, comprising:

a container comprising a container top, a container bottom, an inner wall and an outer wall, said inner and outer walls forming a [hollow] channel there between, said [hollow] channel including a label container area that is in close proximity to said container top, said label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall [[of said label container area]] being translucent such that a label placed in said label container area may be read without being removed from said food storage unit; and

a lid that may be fixably attached to said container top to seal said container CLOSED.